

REMARKS

Claims 2-18, 20, 22, 23, 25, 26, and 29 are pending in this application, with Claims 2, 15, 22, 23, 25, 26, and 29 being independent.

Applicants gratefully acknowledge the indication in the Official Action that Claims 15, 22, 23, 25, and 29 are allowed.

Reconsideration of the outstanding rejections in view of the foregoing amendments and following remarks is respectfully requested.

Ground of Rejection

Claims 2-14, 16-18, 20, and 26 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 1,808,068 ("Rafton"). The rejection is respectfully traversed.

The Official Action asserts,

Rafton discloses a paper sheet, and a method for making same, comprised of sulphite/soda pulp fibers (i.e. wood pulp) having an alkaline filler, e.g. calcium carbonate magnesium hydroxide (corresponding to the claimed 'ammonium-containing compound filler particles), in an amount of about 14% (see examples,), and an inorganic alkali metal salt, e.g. sodium silicate or ammonium. (Official Action at Page 2).

Claimed Subject Matter

Claim 2 recites a wrapper of a smoking article of an electrical smoking system wherein tobacco is contained by the wrapper, the wrapper comprising a cellulosic web material and at least one filler therein, the filler being effective to reduce the content of gaseous components in the smoke produced upon combustion/pyrolysis of the smoking article in the electrical smoking system, wherein the filler includes an

ammonium-containing compound filler particles in an amount effective to reduce aldehyde content in the mainstream smoke produced upon combustion/pyrolysis of the smoking article wherein the electrical smoking system does not produce sidestream smoke.

Claim 26 recites a web of a cigarette of an electrical smoking system comprising a cellulosic web material and a filler consisting essentially of magnesium ammonium phosphate and/or calcium ammonium phosphate wherein the electrical smoking system does not produce sidestream smoke.

Misinterpretation of Rafton

The rejection is traversed on the basis that Rafton is misinterpreted in the Official Action. For instance, whereas the only mention of ammonium is in connection with using soluble salts such as ammonium chloride or ammonium sulphate in place of alum as precipitant for sodium silicate, the Official Action contends that Rafton's alkaline filler corresponds to "ammonium containing compound filler particles" (Official Action at page 2). The only disclosed "fillers" in Rafton are calcium carbonate, calcium carbonate magnesium basic carbonate, calcium carbonate magnesium hydroxide and other substantially water insoluble normal or basic carbonates of alkaline earth metals (Rafton at page 3, lines 40-62). Ammonium is not mentioned in the list of "fillers" and thus there is no basis for the assertion that Rafton's alkaline filler corresponds to an ammonium-containing compound. On this basis alone, the rejection is untenable and should be withdrawn.

Rafton discloses paper containing fibrous furnish (e.g., sulphite and soda pulps), inorganic alkali metal salt (sodium silicate), alkaline filler (e.g., calcium

carbonate magnesium hydroxide), and precipitant (e.g., alum). (See, for example, Page 2, Lines 99-128 of Rafton). Rafton further discloses ammonium salts such as ammonium chloride or sulphate as possible precipitants. (Rafton at page 3, Lines 24-33). However, soluble ammonium salts such as ammonium chloride or sulphate disclosed by Rafton are unsuggestive of the claimed ammonium-containing compound filler particles and there is no suggestion in Rafton of cigarette paper or wrappers of smoking articles. Accordingly, it is respectfully submitted that Rafton has been misinterpreted in the Official Action, the rejections should be withdrawn.

Rafton Is Non-Analogous Prior Art

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). MPEP § 2141.01(a).

Applicants respectfully submit that Rafton is nonanalogous art to the present claims. Rafton is not directed to manufacture of cigarette paper. Instead, the principal object of Rafton is to provide a method of incorporating into paper filled with alkaline filler certain originally and normally soluble constituents in a substantially insoluble form. (Page 1, Lines 3-7). There is no mention in Rafton of "wrapper" or of an electrical smoking system. Nor is there any mention in Raft of a compound which reduces aldehyde content in mainstream smoke. In contrast, Claims 2 and 26 are directed to a wrapper of a smoking article or web of a cigarette of an electrical smoking system.

It is submitted that Rafton may not be relied upon as a basis for the obviousness rejection set forth in the Official Action since Rafton is not reasonably pertinent to the particular problem with which the inventor was concerned, formation of aldehydes during actuation of an electrically heated smoking article. Accordingly, because Rafton is non-analogous prior art, the rejection should be withdrawn.

Establishing a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2142.

Applicants respectfully submit that Rafton does not disclose or suggest all the claim limitations. Rafton discloses paper containing fibrous furnish, inorganic alkali metal salt, alkaline filler, and precipitant, which is unsuggestive of a wrapper of a smoking article of an electrical smoking system including ammonium-containing compound filler particles in an amount effective to reduce aldehyde content in the mainstream smoke produced upon combustion/pyrolysis of the smoking article, as recited in Claim 2, or a web of a cigarette of an electrical smoking system including filler consisting essentially of magnesium ammonium phosphate and/or calcium ammonium phosphate, as recited in Claim 26. The speculation set forth in the

Official Action regarding how the paper of Rafton might behave if used as cigarette paper and if it contained ammonium compound filler particles is not supported by substantial evidence and as such the rejection should be withdrawn.

Weight of the Preamble

As explained in MPEP § 2111.02, the preamble is given the effect of a limitation when it is "essential to point out the invention defined by the claim." *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

While the Official Action asserts, "A claim containing recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim" (Official Action at Page 2), Applicants respectfully submit that recitation of a "wrapper of a smoking article of an electrical smoking system" and a "web of a cigarette of an electrical smoking system" in the preamble of Claims 2 and 26, respectively, must be given the effect of a limitation as they are essential to point out the invention defined by the claims (rather than an intended use of the claimed invention, as asserted on page 2-3 of the Official Action). As explained on page 1, lines 3-7, of the present application,

The present invention relates to smoking article wrappers. In particular, the invention relates to ammonium-containing compounds used as novel fillers in paper wrappers for smoking articles which are effective in selectively reducing the content of gaseous components, such as low molecular weight aldehydes, from the smoke produced during the use of such smoking articles.

Furthermore, Applicants respectfully submit that despite the assertion in the Official Action that, "[w]hile not specifically articulated as such, the paper of Rafton is capable of being used as a wrapper for a smoking article" (Official Action at Page 2),

there is no suggestion in Rafton that the paper disclosed therein may suitably or appropriately be used as a wrapper or web of a cigarette or smoking article, specifically for a cigarette or smoking article of an electrical smoking system, which does not produce sidestream smoke. The speculation set forth in the Official Action regarding whether or not the paper of Rafton would be suitable for use as cigarette paper is not supported by substantial evidence and as such the rejection should be withdrawn.

Impermissible Grounds for Rejection

So long as a judgment on obviousness takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from Applicants' disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971); MPEP § 2145.

Applicants respectfully submit that the Official Action has impermissibly resorted to "hindsight" based upon Applicants' disclosure. Specifically, the assertion in the Official Action that the theory that "when heated at temperatures reached during smoking, ammonium salts release ammonia gas (in addition to carbon dioxide and water), which then would reduce the level of aldehyde in the cigarette smoke by chemical reaction ... ***is even clear from Applicant's Table 1 on page 8 of the instant specification***" (emphasis added) (Official Action at Page 3) is not based on teachings in the prior art. Rather, the Official Action improperly cites Applicants' disclosure to support the rejection. The speculation set forth in the Official Action regarding what would happen to cigarette smoke if Rafton's paper was used as

cigarette paper is not supported by substantial evidence and as such the rejection should be withdrawn.

Reliance on Scientific Theory

When an examiner relies on a scientific theory, evidentiary support for the existence and meaning of that theory must be provided. *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979); MPEP § 2144.02. Further, obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); MPEP § 2141.02(V).

With regard to the assertion in that "it is well-known/evident that when heated at temperatures reached during smoking, ammonium salts release ammonia gas (in addition to carbon dioxide and water), which then would reduce the level of aldehyde in the cigarette smoke by chemical reaction" (Official Action at Page 3), Applicants respectfully request that evidentiary support for the existence of that scientific theory be provided. *See Grose, Id.* As pointed out above, the ammonium salts disclosed by Rafton are soluble and would not be capable of use as "filler particles." Rafton fails to teach ammonium compound filler particles and whether or not evidence can be found to support the assertion set forth in the Official Action regarding ammonium salts, Rafton fails to suggest the claimed subject matter. As such, the rejection should be withdrawn.

The dependent claims set forth further patentable features. For instance, Rafton fails to suggest the compounds recited in Claims 3 and 4, the filler content recited in Claims 5 and 13, the basis weight and CORESTA values recited in Claims 7 and 8, the burn additive features recited in Claims 9-11, the mineral phases recited

in Claim 16, at least two different ammonium compounds recited in Claim 17, the wrapper on a tobacco rod recited in Claim 18 or the perforations/film forming agent recited in Claim 20.

For at least the above-noted reasons, Applicants respectfully submit that Claims 2-14, 16-18, 20, and 26 are patentable over Rafton. Accordingly, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

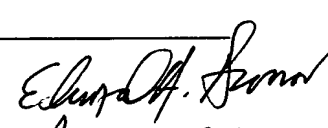
Respectfully submitted,

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